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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/502,447

03/07/2005

Veronique Ferrari

05725.1370

3679

22852

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04/23/2009

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER

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EXAMINER

POCHAS, CHRISTOPHER M

ART UNIT

PAPER NUMBER

4121

MAIL DATE

DELIVERY MODE

04/23/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/502,447

Applicant(s)

FERRARI, VERONIQUE

Examiner

Christopher Pochas

Art Unit

4121

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 March 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 35-84 is/are pending in the application.
- 4a) Of the above claim(s) 38,39,43,52-61 and 79-84 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 35-37,40-42,44-51 and 62-78 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☒ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 3/7/2005, 9/28/2006
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Detailed Office Action

Election/Restrictions

1) Applicant's election with traverse of group I, claims 35-78 in the reply filed on 3/26/2009 is acknowledged. The traversal is on the ground(s) that the present claims share the common technical relationship of a composition comprising the elements set forth in claim 1. This is not found persuasive because the shared technical feature is not novel. It has been disclosed in U.S. Patent No. 6464969 and is therefore not "special" within the meaning of PCT Rule 13.2.

The requirement is still deemed proper and is therefore made FINAL.

2) Claims 79-84 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to nonelected groups, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 3/26/2009.

3) Applicant's election with traverse of a semi-crystalline polymer and a volatile oil in the reply filed on 3/26/2009 is acknowledged. The traversal is on the ground(s) that the examiner merely asserted that species are deemed to lack unity. This is not found persuasive because the species are not novel, a volatile

oil and a semi-crystalline polymer are disclosed in U.S. Patent No. 6464969, discussed further below.

4) Claims 38, 39, 43, 52-61 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 3/26/2009.

Priority

5) This application is a 371 application of PCT/FR02/03801 which claims priority to French applications 02/00885 and 02/02358. French application 02/00885 has been submitted and is in compliance, however 02/02358 has not. Accordingly, the claims currently receive the priority date of the PCT application because no English copies of the French documents have been provided.

Non Final Rejection

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. The term "sparingly" in claim 70 is a relative term which renders the claim indefinite. The term "sparingly" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the

art would not be reasonably apprised of the scope of the invention. A single example is given of a sparingly polar oil in the instant specification, however that is not enough to determine the entire scope of pending claim, because no actual measure of any dipole moments are recited and the term "sparingly" is therefore not defined. Furthermore it is not clear if the polar oil is the same or different in its polarity when compared to the sparingly polar oil.

3. Claims 36 and 37 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. These claims depend on a cancelled claims and as such are indefinite.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 35-37, 40-42, 62, 63, 71-76 are rejected under 35 U.S.C. 102(e) as being anticipated by De La Poterie et al., U.S. Patent No. 6464969, filed June 15, 2001.

Claims 35-37, 40-42, 62, 63, 71-76 U.S. Patent No. 6464969 (hereafter the 969 patent) discloses in example 12 of column 16 a composition which anticipates pending claim 35. It discloses a polyethylene wax with a melting point of 83.9 °C, which is the semi-crystalline polymer, black iron oxide which is the colorant, and isododecane, the volatile oil as well as other oils (column 16, lines 25-62). The paragraph of line 46 of column 3 discloses that the polyethylene waxes are semi-crystalline. Note that the paragraph discloses that this polymer is a thermal transition agent. For the purpose of this prior art rejection the examiner assumes that pending claims 36 and 37 are meant to depend on pending claim 35, and that the number 34 in these claims is a typo. Note that isododecane as per pending claim 36 has a boiling point at atmospheric pressure of less than 220 °C, as evidenced by the isododecane material safety data sheet obtained from <http://www.bpilabs.com/msds/Isododecane.pdf>, accessed April 20th, 2009, included with this action. Also note that it is a volatile hydrocarbon based oil having 12 carbon atoms as per pending claims 37, 41, and 42. Note that it is branched, as per pending claim 40, is an isoalkane as per pending claim 41 and anticipates pending claim 42. Note that the semi-crystalline polymer of example 12 is present at 20% relative to the total weight of the composition as per pending claims 62 and 63. Note that the ratio of the semi-crystalline polymer to the liquid fatty phase (60g of the dispersion plus 10 g of the mixture of oils) is 0.29 as per pending claims 71 and 72. Note that the composition has 0% was and/or matting filler as per pending claim 73. Note that the composition contains no water and is therefore anhydrous as per pending claim 74. Note that the composition is a mascara as per pending claim 76. Note that the casting of pending

claim 75 is directed to a process for making the product rather than the product itself, and as such does not further define or limit the product.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. Claims 44-51 and 64-70, 77, and 78 are rejected under 35 U.S.C. 103(a) as being unpatentable over De La Poterie et al., U.S. Patent No. 6464969, filed June 15, 2001 in view of Mercado et al., U.S. Patent 4996044, issued February 26th, 1991.

The 969 patent has been discussed supra. The 969 patent does not disclose the specific ranges of pending claims 44-49, however it would have been prima facie obvious to one of ordinary skill in the art to optimize the ranges of the ingredients of these claims. Furthermore, because the prior art and the instant application both teach

these ingredients as being used for the same purpose; makeup for a keratinous material, the optimization of ranges by routine experimentation would lead to the same amounts in both cases. Note section 2144.5 of the MPEP which states, "[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." In re Aller, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955).

Concerning pending claims 51 and 52, due to the similarity between the melting points of the polymers of the prior art and the pending claims, the examiner asserts that the molecular masses disclosed in example 12 and the paragraph of line 43 of column 6 of the 969 patent are likely overlapping. Should it be found that these ranges do not overlap, it would have been prima facie obvious to one of ordinary skill in the art to optimize the molecular masses of these polymers (see MPEP section 2144.5 quote, above). Furthermore, the optimization of ranges in these cases would lead to the same values because the prior art and instant application both teach that the compositions they disclose are for forming a film on keratinous material (see the abstract of the 969 patent and line 7 of page 33 of the instant specification and also note that the paragraph of line 30 of column 4 of the 969 patent discloses that the thermal transition agent i.e. the semi-crystalline polymer may also be the film forming polymer).

Concerning the polymers and temperatures of pending claim 64-67, these are not explicitly recited by the 969 patent in a single embodiment. However the paragraph of line 46 of column 3 of the 969 patent discloses that the at least one thermal transition agent (also the film forming polymer in some embodiments) has a melting point which

overlaps with the melting points of the pending claims. Furthermore the inclusion of the phrase "at least one" suggests that a combination of two or more such polymers can be used, as per the pending claims. The ranges of pending claims 68 and 69 also do not add patentable distinctness to the pending claims because it would have been *prima facie* obvious to one of ordinary skill in the art to make the modifications in these claims because the 969 patent suggests that these modifications may be made (see MPEP section 2144.5 quote, above). Concerning pending claim 70, note the indefiniteness rejection above, and also note that the examiner asserts that the materials of example 12 of the 969 patent read on the oils of pending claim 70. Concerning the stick and lipstick of pending claims 77 and 78, note that the paragraph of line 13 of column 1 of the 969 patent discloses that the composition of its invention may be a product for the lips, and a lipstick is an obvious cosmetic product for the lips. The examiner also asserts that the waxes disclosed in the 969 patent and the amounts they may be present in would provide the hardness of pending claim 77, because waxes are known to be useful in hardening lipstick compositions, as is evidenced by U.S. Patent 4996044 (hereafter the 044 patent), lines 1-7 of column 4. Furthermore, it would have been *prima facie* obvious to one of ordinary skill in the art to optimize the hardness of the composition. One would have been motivated to do this by the 044 patent, which discloses that lipsticks should have a certain hardness.

Finally, concerning the elected semi-crystalline polymers; behenyl acrylate and stearyl acrylate homopolymers, the polymers disclosed in the first paragraph of column 5 of the 969 patent differ from these polymers by only one methyl group on each

monomer. As such these polymers are homologs of the polymers elected in the instant application. Section 2144.09 of the MPEP states, "Compounds which are position isomers (compounds having the same radicals in physically different positions on the same nucleus) or homologs (compounds differing regularly by the successive addition of the same chemical group, e.g., by -CH₂- groups) are generally of sufficiently close structural similarity that there is a presumed expectation that such compounds possess similar properties. In *re Wilder*, 563 F.2d 457, 195 USPQ 426 (CCPA 1977)

Double Patenting

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 35-37, 40-42, 44-51, and 62-78 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-53 of U.S. Patent No. 6949504 in view of De La Poterie et al., U.S. Patent No. 6464969, filed June 15, 2001.

U.S Patent No. 6949504 (hereafter the 504 patent) claims a composition differing from the instant claims only by the inclusion of at least one volatile oil in the instant claims, and the inclusion of a second polymer in the 504 patent. One would have been motivated to add the at least one volatile oil by example 12 of the 969 patent, discussed supra. Furthermore, one would have been motivated to include a second polymer by the 969 patent as has been discussed supra, as well as by the claims of the 504 patent, which include compositions having 2 polymers with different melting points and those melting points overlap with the melting points of instant claims 64-67. It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to include the second polymer and at least one volatile oil because the 969 patent suggests the addition of a volatile oil and the 969 and 504 patents suggest the use of more than one semi-crystalline polymer. The addition of a colorant to a composition of this nature is suggested by the 969 patent, which discloses black iron oxide colorants in its example 12, discussed supra. The patent claim 1 and instant claim 35 recite overlapping melting points for the semi-crystalline polymer and in the case of overlapping ranges, a prima facie case of obviousness exists. Also, note that the instant claim melting point of at least 30 degrees Celsius reads on the patent claim

language "solid at ambient temperature." Concerning the structural differences between the patent and instant polymer, it would have been prima facie obvious to substitute one semi-crystalline polymer for another, provided it had the proper melting point and the 969 patent suggests that any such polymer which is also suitable for application to this skin would be acceptable. All other modifications to the instant claims and the way in which they are obviated have been discussed supra.

8. Claims 35-37, 40-42, 44-51, and 62-78 are rejected on the of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-63 of U.S. Patent No. 7129276 in view of De La Poterie et al., U.S. Patent No. 6464969, filed June 15, 2001.

The instant claims differ from the claims of U.S. Patent No 7129276 (hereafter the 276 patent) only in the inclusion of a second polymer with a different melting point in the claims of the 276 patent as well as the inclusion of a colloidal dispersion of particles in the 276 patent. The addition of a second polymer in the instant claims is obviated by the 969 patent, discussed supra, as well as the 276 patent which suggests including two such polymers having different melting points. Furthermore, the addition of the colloidal, dispersed particles is obviated by example 12 of the 969 patent, which includes pigment particles as well as poly(methylacrylate/acrylic acid) particles. Note that because these particles are part of a dispersion, a dispersing agent is used. The addition of a colorant to a composition of this nature is suggested by the 969 patent,

which discloses black iron oxide colorants in its example 12, discussed supra. The patent claim 1 and instant claim 35 recite overlapping melting points for the semi-crystalline polymer and in the case of overlapping ranges, a prima facie case of obviousness exists. Also, note that the instant claim melting point of at least 30 degrees Celsius reads on the patent claim language "solid at ambient temperature." Concerning the structural differences between the patent and instant polymer, it would have been prima facie obvious to substitute one semi-crystalline polymer for another, provided it had the proper melting point and the 969 patent suggests that any such polymer which is also suitable for application to this skin would be acceptable. All other modifications to the instant claims and the way in which they are obviated have been discussed supra.

The examiner is aware of the following pending applications which raise similar obviousness-type double patenting issues: 10/502448 and 11/147236.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher Pochas whose telephone number is (571)270-7722. The examiner can normally be reached on Monday to Friday 8 AM to 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Nolan can be reached on (571)272-0847. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/CMP/

/Patrick J. Nolan/
Supervisory Patent Examiner, Art Unit 4121